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| MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC<br>8321 OLD COURTHOUSE ROAD<br>SUITE 200<br>VIENNA, VA 22182-3817 |             |                      | EXAMINER<br>HEWITT II, CALVIN L |                  |
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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/805,978  
Filing Date: March 15, 2001  
Appellant(s): OHTA, YOSHINORI

John I. Dresh, Reg. No. 46,672, Sean M. McGinn, Reg. No. 34,386  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 23, November 2005 appealing  
from the Office action mailed 24 May 2005.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

|                  |                              |               |
|------------------|------------------------------|---------------|
| <b>4,839,829</b> | <b><i>FREEDMAN</i></b>       | <b>6-1989</b> |
| <b>5,960,411</b> | <b><i>HARTMAN et al.</i></b> | <b>9-1999</b> |

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Response to Amendment/Argument***

Applicant is of the opinion that the prior art does not teach Applicant's claimed invention. Specifically, Applicant asserts that the combined teachings of Freedman and Hartman et al. do not teach or suggest "a determination unit for determining, on the basis of the correspondence data, which of the plurality of second client computers is affiliated with the orderer specified by the orderer data received by said first receiving unit". The Examiner respectfully disagrees. Freedman teaches a system for ordering print related goods and services, wherein said order comprises a user choice of print facility for fulfilling said order ('829, column 10, lines 19-32). To one of ordinary skill, Hartman et al. provide a teaching for more efficiently entering order data by storing order data to be used for future orders in memory ('411, column 10, lines 15-35), such as a print facility ('829, figure 1A). A feature at least suggested by Freedman ('829, column 8, lines 20-25). Further, this creates an "affiliation" between the orderer and the print facility, the affiliation being print facilities that the orderer has ordered from (note this also applies to claim 33).

Applicant has also added claims 25-33. Claims 25-32 are directed to data stored at an apparatus. However, it has been held that in order for a claimed structure to differentiate from the prior art, the differences have to be found in the respective structures and not functionality (*In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Therefore, as both Freedman and Hartman et al. store data in databases the prior art teach Applicant's apparatus. Regarding databases, the Examiner takes Official Notice that relational databases and data models (e.g. a table that links data by a unique identifier such as an account number, social security number or ID) are old and well known.

### ***Claim Rejections - 35 USC § 103***

Claim 1-7, 11-14, 16, 17, and 19-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, U.S. Patent No. 4,839,829 in view of Hartman et al., U.S. Patent No. 5,960,411.

As per claims 1-7, 11-14, 16, 17, and 19-33 (correcting a typo, in the Office Action it was incorrectly written as 19-24), Freedman teaches an image ordering system comprising:

- a server, first client computer and a second computer connected via a communication network (figures 1A-B)

- a first client computer comprising: an input unit for specifying an image and a transmitting unit for transmitting to a server said image specifying data (abstract; figures 1A-B)
- server comprising: receiving unit for receiving image specifying data, transmitting unit for image and orderer specifying data to a second client computer (abstract; figures 1A-B; column/line 7/62-8/35)
- a server with an image database for storing thumbnail images (column/line 8/55-9/63)
- a server with calculation unit that calculates an estimated fee for printing an image based on image specifying data, transmitting the fee (e.g. of orderers affiliated with a second client computer) to a client computer (column/line 9/63-10/35)
- a first client computer that receives a fee estimate from the server and an alerting unit for giving notice of the estimate (column/line 9/63-10/35)
- second client computer comprising: receiving unit for receiving image specifying and orderer data, printer controller, and an alerting unit (abstract; figures 2B; column 8, lines 1-20; column 10, lines 27-35)
- a first setting unit for setting at least one of a lab affiliated with an agency and an orderer affiliated with a lab and for transmitting this data to a server (column/line 7/62-8/14; column 10, lines 15-35)

Freedman also teaches an image ordering system that comprises a server transmitting order parameters to a first and second client computers (column 10, lines 15-35). Freedman teaches a second client computer giving notice of information received regarding received data such as acceptance of a print job and responses to inquiries regarding job status (column 10, lines 31-54). Freedman doesn't specifically recite transmitting fee data or orderer specifying data to a second client computer. However, Freedman recites the server transmitting image specifying data and all other parameters and other information to second client computer (column 10, lines 27-35), hence, it would have been obvious to one of ordinary skill for the server to send first client identity data and/or a replica of the receipt (e.g. specifying data, prices) sent to the first client computer (column 10, lines 33-35) to facilitate the matching and resolution, in the case of discrepancies, of orders. However, Freedman does not specifically storing order data for use in subsequent orders. Hartman et al. teach a network ordering system comprising a server with memory for retaining client order preferences for use in subsequent orders and a determining unit fulfilling orders based on the preference data (abstract). Therefore it would have been obvious to one of ordinary skill to combine the teachings of Freedman and Hartman et al. in order to make the ordering process more efficient.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freedman, U.S. Patent No. 4,839,829 and Hartman et al., U.S. Patent No. 5,960,411, as applied to claim 5 above, and in further view of Greulich et al., U.S. Patent No. 6,018,338.

As per claims 8-10, Freedman teaches a network ordering method and system that connects over a communication link a server, a first client computer and a second client computer and transmits image specifying data and all other parameters and other information between the parties (abstract; figures 1A-2B; column 10, lines 27-35). Freedman also teaches a first client computer providing a server with payment data (column 8, lines 1-10) and a second client computer accepting the order (column 10, lines 30-35). The latter, suggests, to one of ordinary skill, a verification unit and that a second client computer may choose not to accept the order if the order data and all other parameters and other information was found unacceptable. Hartman et al. teach a network ordering system comprising a server with memory for retaining client order preferences for use in subsequent orders and a determining unit fulfilling orders based on the preference data (abstract; figures 1C, 3, 4 and 8A-C; column 3, lines 58-66; column 4, lines 30-67; column/line 5/55-6/21; column 6, lines 45-52). However,



neither Freedman nor Hartman et al. specifically recite transmitting fee data to a third client computer. Greulich et al. teach a network ordering system and method that comprises a third party for verifying a first client ability to pay for a service provided by the second client computer (figure 1; column 5, lines 45-51). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Freedman, Hartman et al., and Greulich et al. in order to prevent fraud.

#### **(10) Response to Argument**

The following assertion of facts by the Examiner have gone unchallenged by the Appellant and are considered admitted prior art:

- relational databases and data models (e.g. a table that links data by a unique identifier such as an account number, social security number or ID)

*Claims 1-7, 11-14, 16, 17 and 19-24, claims 8-10, and claim 33*

Appellant is of the opinion that the combined prior art of Freedman and Hartman et al. fails to teach Appellant's claimed system. Specifically, Appellant asserts that the prior art combination does disclose "a determination unit for determining, on the basis of the correspondence data, which of the plurality of second client computers is affiliated with the orderer specified by the orderer data received by said first receiving unit." The

Examiner respectfully disagrees. Freedman is directed to a client server system for ordering images ('829, figures 1A-B; column 4, lines 36-41; column 10, lines 15-35), wherein a first client computer for placing an order ('829, figure 1A; column 4, lines 42-44), a server ('829, figure 1A; column/line 4/66-5/9) and a plurality of second client computers for fulfilling the order ('829, figure 1A; column 6, lines 37-63) are in communication with each other. When placing an order, a user enters image parameters such as the number of pages, font, layout, design, etc. ('829, column/line 8/36-9/44). A user can also select a particular facility, machine or mix of machines to produce to the ordered image ('829, column 10, lines 20-24). To one of ordinary skill, the image parameters and the production facility (i.e. one of a plurality of second client computer) comprise *an order*, as this (i.e. image parameters and selected facility) is what is authorized by the user, and results in the production of the desired image ('829, column 10, lines 26-33). Hartman et al. teach a method for more placing an order by retaining client order preferences for use in subsequent orders and a determining unit fulfilling orders based on the stored preference data (i.e. memory for storing correspondence data in advance-claim 14) ('411, abstract; figures 1C-2; column 2, lines 32-37; column 7, lines 4-13). Therefore, the combined prior art teaches a determination unit ('411, figures 1C-2; column 7, lines 4-13) for determining, on the basis of the correspondence data ('411, column 7, lines 4-13), which of the plurality of second client computers ('829, column 10, lines 20-24) is affiliated with the orderer specified by the orderer data ('829, column/line 8/36-9/44; column 10, lines 20-24) received by said first

receiving unit ('829, figure 1A; column/line 4/66-5/9). In the "Background of the Invention", Hartman et al. disclose storing past orders for future use ('411, column 2, lines 32-37) while this feature is at least suggested by Freedman, as Freedman allows a user to order images using the data from past orders ('829, column 8, lines 20-24). Hence, it would have been obvious to one of ordinary skill to combine the teachings of Freedman and Hartman et al. in order to more efficiently place and process customer orders.

Appellant is also of the opinion that the prior art does not teach or fairly suggest an affiliation between the user's computer and the printing facility (Brief on Appeal, page 22, lines 1-9; page 26, lines 1-3). However, this analysis is based on an analysis of what the Freedman and Hartman et al. teach individually, and it has been held that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references (*In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)). Freedman teaches constructing an order comprising image parameters ('829, column/line 8/36-9/44; column 10, lines 20-24) and a user selected facility, machine or mix of machines for producing the image ('829, column 10, lines 20-24). Hartman et al. teach storing past order data for re-use in subsequent orders ('411, abstract; figures 1C-2; column 2, lines 32-37; column 7, lines 4-13). Therefore, the combined system allows for a user's order preferences, such as a preference for a particular facility (i.e. one of a plurality of second client computers) as well as a particular font or layout, to be saved

and re-used. Regarding “affiliation”, Appellant has not provided a specific definition of the term, and the Specification vacillates between equating “affiliate” (Specification, figure 1; paragraphs [0035] and [0081]) with “associate” (Specification, figure 1; paragraphs [0035], [0081], and [0318]) and a “master-slave” relationship (Specification, paragraphs [0105] and [0122]). In either case, an affiliation between a user computer and a production facility is taught by the prior art. According to Freedman, a production facility computer(s) is broadly “associated” with a user computer as each is a component of the system of Freedman ('829, figure 1A) and the user selects the facility for producing a desired image ('829, column 10, lines 20-24), similarly the production facility is in a “master-slave” relationship with the user computer as it receives image production instructions from the user and cannot produce an image for a user without said instructions.

#### *Claims 25-33*

Claim 1 is directed to an apparatus or structure. This is necessarily so, as the four statutory classes are machine, article of manufacture, composition of matter or process. Therefore, in order to fall within the guidelines defined by 35 U.S.C. 101 (and 112 Second Paragraph see *Ex Parte Lyell*, 17 USPQ2d 1548 (BPAI 1990); *IPXL Holdings v Amazon.com*, 430 F.3d 1377,1384 (Fed. Cir. 2005)) Appellant's claim 1 is an apparatus (i.e. machine) albeit a distributed one. The structure of Appellant's claim 1 is

well defined it comprises a server, first and second client computer, and describes how these parts interact with each other to create Appellant's "system". The server further comprises a memory for storing data. In order to be distinguished from the prior art servers of Freedman ('829, figure 1A; column/line 4/66-5/9) and Hartman et al. ('411, figure 2), individually or in combination, the differentiating feature must be found in Appellant's server and not in the data stored in its memory (i.e. what the server is used for or its function). Nonetheless, all that is required by the prior art in order to teach claim 25 is a database that includes **at least one of** a table of user names, company names, company-user link information, company master-slave information, for setting system services, for setting print services, of orders, of products, or for specifying consignees. Hartman et al. discloses a database for storing user names and orders ('411, figure 2). Freedman discloses storing orders ('829, column 5, lines 50-55; column 8, lines 20-24; column 10, lines 40-45), company names (in order to draw parameters from different printing facilities to provide a cost estimate to a user ('829, column 10, lines 15-20), and system and print services ('829; column 10, lines 15-20), while the combined prior art teaches storing a user-print facility or company link ('411, abstract; figures 1C-2; column 2, lines 32-37; column 7, lines 4-13; '829, column/line 8/36-9/44; column 10, lines 20-24; '829, column 8, lines 20-24; column 10, lines 20-24). Relational databases or tables for storing data are old and well known (see above reference to unchallenged assertion of facts), therefore, the prior art teaches or at least clearly suggests the features of the **at least one of** table required by claim 25 (**at least one of**

a table of *user names*, company names, *company-user link information*, company master-slave information, for setting system services, for setting print services, of *orders*, of products, or for specifying consignees) (Note: The Specification is more detailed regarding the description of these tables, however, as limitations from the specification are not read into the claims, they cannot be relied upon to differentiate the claims from the prior art- *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)). Similarly, as relational databases (i.e. tables) use unique identifiers to link or “join” data (see unchallenged assertion of facts above), the combined Freedman and Hartman et al. system teaches company names and company-user link information “linked” by the unique identifier assigned to each company in order to uniquely identify each company.

Regarding claims 27-30, in each instance, Appellant describes linking at least two of the tables recited in claim 25. Claim 25, on the other hand, merely ***requires at least one*** table. When claim 25 has only (i.e. at least one) one table, claims 27-30 cannot happen, therefore by rejecting claim 25, claims 27-30 are also rejected.

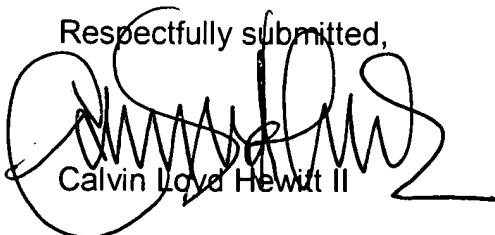
As per claims 31 and 32, regarding “affiliation”, Appellant has not provided a specific definition of the term, and the Specification vacillates between equating “affiliate” (Specification, figure 1; paragraphs [0035] and [0081]) with “associate” (Specification, figure 1; paragraphs [0035], [0081], and [0318]) and a “master-slave” relationship (Specification, paragraphs [0105] and [0122]). According to Freedman, a production facility computer(s) is broadly “associated” with a user computer as each is a

component of the system of Freedman ('829, figure 1A) and the user selects the facility for producing a desired image ('829, column 10, lines 20-24), similarly the production facility is in a "master-slave" relationship with the user computer as it receives image production instructions from the user and cannot produce an image for a user without said instructions. Similarly, as relational databases (i.e. tables) use unique identifiers to link or "join" data (see unchallenged assertion of facts above), the combined Freedman and Hartman et al. system teaches company names and company-user link information "linked" by the unique identifier assigned to each company in order to uniquely identify each company, as well as user name and user-company link information (common unique user id), user and order (common unique user id) ('829, column 10, lines 35-40), and company and products ('829, column 10, lines 55-65).

For the above reasons, it is believed that the rejections should be sustained.


#### **(11) Related Proceeding(s) Appendix**


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,  
  
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